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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,283	10/20/2003	Thomas E. Valiulis	502454	3164

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EXAMINER

HOGUE, GARY CHAPMAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,283

Applicant(s)

VALIULIS, THOMAS E.

Examiner

Gary C Hoge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/9/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, 26 and 27, drawn to a labeling system, classified in class 40, subclass 642.02.
 - II. Claims 14-18, drawn to a method of labeling merchandise, classified in class 156, subclass 249.
 - III. Claims 19-25, drawn to a labeling sheet, classified in class 428, subclass 40.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as providing an adhesive backed label and applying the label to the front surface of the merchandiser.
3. Inventions III and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as a removable label on a product.

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4. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination does not require a merchandiser. The subcombination has separate utility such as a removable label on a product.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for Group I is not required for Groups II and III, the search required for Group II is not required for Groups I and III, the search required for Group III is not required for Groups I and II, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Andrew J. Heinisch on November 22, 2004 a provisional election was made with traverse to prosecute the invention of group I, claims 1-13, 26 and 27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9, 12, 13, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebka.

Gebka discloses a labeling system 10 for using labels 22 to provide information pertaining to merchandise, comprising a merchandiser adapted to support said merchandise; a label holder 14 mounted to the merchandiser, the label holder including means for supporting one or more labels 22 without an adhesive bond; and a label removably secured to the label holder by the support means, the label including a face stock having printed indicia thereon relating to the merchandise. However, the label disclosed by Gebka doesn't include a friction coating. Instead, the label holder includes a friction coating. It would have been obvious to one having ordinary skill in the art at the time the invention was made to put the friction coating on the label instead of the holder because it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

Regarding claim 2, it would have been obvious to make the label of the dimensions recited, because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 3, it is not known what material is used to fabricate the label. However, since it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having ordinary skill in the art would know that paper would be suitable for the fabrication of the label, it would have been obvious to one having ordinary skill in the art at the time the invention

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was made to fabricate the label from paper as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

Regarding claim 5, the recitation that the label includes a bar code and a price does not patentably define over Gebka because it has been held that patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure. *In re Montgomery*, 102 USPQ 248.

Regarding claims 6 and 7, it is not known what the range of the skid value is. However, it would have been obvious to make the friction coating have the range of skid values recited because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 8, 9, 26 and 27, it is not known what the range of the release value is. However, it would have been obvious to make the friction coating have the range of release values recited because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gebka in view of Wildrick.

Gebka discloses the invention substantially as claimed, as set forth above. However, the label holder is not comprised of two generally co-planar plastic panels. Wildrick teaches that it was known in the art to make a label holder out of two generally co-planar plastic panels. It would have been obvious to one having ordinary skill in the art at the time the invention was

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made to make the label holder disclosed by Gebka out of two generally co-planar plastic panels, as taught by Wildrick, in order to protect the face of the label from abrasion.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gebka in view of Slavsky.

Gebka discloses the invention substantially as claimed, as set forth above. However, the label holder is not curved. Slavsky teaches that it was known in the art to make a curved label holder. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the label holder disclosed by Gebka curved, as taught by Slavsky, in order to hold the label in place more securely.

Double Patenting

11. Applicant is advised that should claims 8 and 9 be found allowable, claims 26 and 27 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). In this case, claim 26 is a verbatim duplicate of claim 8, and claim 27 is a verbatim duplicate of claim 9.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

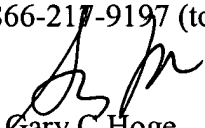
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C Hoge whose telephone number is (703) 308-3422. After

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April 5, 2005, the examiner's telephone number will be (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gary C Hoge
Primary Examiner
Art Unit 3611

gch